

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1, 7-14 and 18 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-21 remain pending in this application.

Rejections under 35 U.S.C. § 101:

Claims 18-21 stand rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. Applicant respectfully traverses this rejection for at least the following reasons.

The Examiner has failed to substantively address any of Applicant's previous arguments regarding patentability of claims 18-21 under 35 U.S.C. § 101 in view of both the Manual of Patent Examining Procedure (MPEP) guidelines and the United States Court of Appeals for the Federal Circuit decision. Instead, the Examiner has simply reiterated his prior arguments that "the program product must be tangibly embodied in a manner so as to be executable; therefore, the claims 18-21 are still directed to non-statutory subject matter." See Office Action, dated May 11, 2009, page 8, lines 10-12.

Applicant respectfully submits that one of ordinary skill in the art would readily understand that "a computer program product, embodied on a computer-readable medium," as is recited in claim 18, is clearly "executable" by a processor. Applicant has amended claim 18 to more clearly recite this feature. Claim 18 now recites "computer code, when executed by a processor, causes an apparatus to" perform certain method steps.

Further, the originally filed specification and drawings clearly provide a basis for one of ordinary skill in the art to understand that the computer program product is executable by a processor. For example, Figure 4 clearly depicts that the device includes a CPU coupled to a memory. One of ordinary skill in the art would understand that such a configuration enables the CPU to execute program products embodied on the memory.

In addition, both the United States Court of Appeals for the Federal Circuit and the MPEP are clear that a computer program product embodied on a computer-readable medium satisfies the requirements of 35 U.S.C. § 101. In *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994), the Federal Circuit clearly noted that such an arrangement is statutory, noting:

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory.

The guidelines provided in MPEP § 2106.01 are similarly clear, noting that:

"[F]unctional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component...When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized."

Thus, both the United States Court of Appeals for the Federal Circuit and the MPEP are clear in their distinction between stand-alone computer programs, which may not meet the statutory requirements, and programs recited in conjunction with a memory or similar storage medium, which do meet the requirements. Since a computer program product embodied on a computer-readable medium meets the above standard, the present claim language is statutory. Accordingly, claims 18-21 are directed to statutory subject matter under 35 U.S.C. § 101.

Rejections under 35 U.S.C. § 103(a):

Claims 1-21 stand rejected under 35 U.S.C. § 103(a) for allegedly being unpatentable over U.S. Patent No. 6,879,979 to Hindawi et al. (hereinafter “Hindawi”) in view of U.S. Patent No. 7,353,259 to Bakke et al. (hereinafter “Bakke”). Applicant respectfully disagrees with the Examiner’s assertions and, therefore, traverses these rejections for at least the reasons that follow.

In rejecting independent claims 1, 7, 14 and 18 of the present application, the Examiner is arguing that Hindawi teaches all of the claimed features except for certain features relating to flag functionality. However, the Examiner is asserting that these features are described in Bakke, and that it would have been obvious to combine these features with Hindawi. Applicant disagrees with the Examiner’s position for at least the following reasons.

As was discussed Applicant’s previous responses, Hindawi fails to teach or suggest “receiving a provisioning content document from a wireless communication network, the provisioning content document comprising configuration information for a device”. In particular, Hindawi describes sending what are effectively questionnaires (i.e., query documents) from an information requestor to a target computer to inquire about the target computer’s configuration information. Once the information requester receives answers to the query, it can provide better customer services, such as technical support, to the target computer. See, e.g., Hindawi, col. 1, lines 38-40; col. 3, lines 19-24; col. 5, lines 55-65; col. 6, line 66 to col. 7, line 4.

As such, Hindawi describes two types of messages. The first type is a query message, which is sent from the network device to the client device. The second type is a response message, which is sent from the client device to the network device.

A) Hindawi’s query document does not contain configuration information:

Hindawi’s query message cannot read on the pending claims because the query message does not carry “configuration information,” as recited in claims 1, 7, 14 and 18 of the present application. Instead, Hindawi’s query message only comprises questions or inquiries relating to the client device. As is clearly shown in Hindawi’s Figure 2, the query message consists of questions written in “simplified English.” See Hindawi Col. 4, line 35.

These questions are asked in order to determine “presence of certain hardware, software, files, registry, entries, and configuration settings.” See Hindawi, col. 7, lines 26-28. As such, Hindawi’s query document merely contains questions and not configuration information.

In response to the above arguments, the Examiner seems to argue that the mere inquiry regarding configuration settings is equivalent to actually sending such configuration information to the client device. See Office Action, dated May 11, 2009, page 6, lines 10-18. However, the Examiner’s position is incorrect since Hindawi explicitly describes that such a request document only contains *questions* about the target computer’s configuration information. Therefore, Hindawi’s network device cannot be delivering configuration settings (since it does not have them yet).

B) Hindawi’s response message is going to the wrong entity:

With regard to the “response messages” of Hindawi, the response messages are simply going in the wrong direction to satisfy the relevant features of Applicant’s independent claims. For example, at col. 6, lines 63-64, Hindawi specifically teaches “receiving response documents from the client application.” In contrast, Claim 1 recites “receiving a provisioning content document from a wireless communication network.” Therefore, since the response message of Hindawi is being sent from the target computer (i.e., the client) to the network (i.e., the requestor), instead of from the network to the client, the response message of Hindawi is traveling in the wrong direction and, therefore, cannot read on “receiving a provisioning content document from a wireless communication network, the provisioning content document comprising configuration information for a device” or the similar features recited in Applicant’s independent claims.

In response to the above arguments, the Examiner is arguing that Applicant’s claims do not recite such limitation regarding the direction of the configuration information. Applicant respectfully disagrees since, for example, claim 1 clearly recites in-part: “receiving a provisioning document from a wireless communication network.” As such, the provisioning document (comprising the configuration information) is clearly sent from a wireless communication network, which is directly opposite to the direction in which Hindawi’s response messages are transmitted.

C) Hindawi's scheme is in direct contrast to Applicant's claimed features:

As described above, Hindawi's teaches obtaining configuration information regarding a target computer by relying on two messages: a query message and a response message. In contrast, Applicant's independent claims only involve a single provisioning document that is sent from a wireless communication network. The present specification, at page 10, lines 10-13, further supports this unidirectional approach in describing:

“Since client provisioning is a push-type technology (i.e., the server does not know the client's capabilities), device manufacturers will also benefit from the implementation.”

Having a single provisioning document, which is recited in Applicant's claims and supported by the specification, is in direct contrast to Hindawi's scheme that requires both a query and a response message. Accordingly, Hindawi does not teach or suggest Applicant's claimed features.

D) Bakke does not describe the claimed features

The Examiner is relying on Bakke to assert that this reference teaches “identifying a flag parameter in an application characteristic of the plurality of characteristics in the provisioning content document, wherein the flag parameter indicates whether parameters should be set in the configuration of the device,” which is recited in the pending claims. However, the sections of Bakke relied upon by the Examiner (i.e., Bakke, col. 5, line 39 to col. 6, line 48; col. 8 lines 15-26; col. 12 line 31 to col. 13, line 16), while mentioning two types of flags, called the “heartbeat change flag” and the “master flag,” respectively, they fail to teach or suggest “a flag parameter in an application characteristic of the plurality of characteristics in the provisioning document,” which is recited in Applicant's claims. Applicant has specifically described the terms “provisioning document” and “characteristic” in the present specification (see, e.g., page 6, lines 6-13 of the specification). As such, a flag parameter in the context of the present application is specifically related to a provisioning document and an application characteristic of the plurality of characteristics within that provisioning document. Bakke, in contrast, describes flag types that are not related to Applicant's specific claimed features. Therefore, the disclosure of Bakke does not render the claimed features obvious.

E) Bakke fails to cure the deficiencies of Hindawi

The Examiner is relying on Bakke to assert that this reference teaches certain features related to the flag functionality. However, Bakke fails to cure the various deficiencies of Hindawi described in connection with items A through C above. Accordingly, the combination of Hindawi and Bakke fails to render the pending claims obvious under 35 U.S.C. § 103(a).

In order to establish a *prima facie* case of obviousness, “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2142 (emphasis added). Since Hindawi and Bakke, either alone or in combination, fail to teach or suggest each feature of the pending claims, the Office Action fails to establish a *prima facie* case of obviousness.

Therefore, claims 1, 7, 14 and 18 are patentable. Further, claims 2-6, 8-13, 15-17 and 19-21 each depend, either directly or indirectly, from one of allowable claims 1, 7, 14 or 18 and are, therefore, patentable for at least that reason, as well as for other patentable features when these claims are considered as a whole.

Other Claim Amendments:

Applicant has amended claims 1, 7-14 and 18 to clarify certain features and to delete unnecessary language from the preamble. These amendments to the claims are not made for any reason related to patentability.

Conclusion:

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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